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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/215,951 12/18/98 FELL

J 659/489

IM22/0515

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EXAMINER

LEE, L

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

05/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/215,951

Applicant(s)

Fell

Examiner

Laura Le

Group Art Unit
1772



☒ Responsive to communication(s) filed on Apr 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-50 is/are pending in the applicat

Of the above, claim(s) 19-47 is/are withdrawn from consideration

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-18 and 48-50 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention: a composite with two layers with elongated elastic members between and in contact with the two layer with regions of securement securing the elastic members to the two layers where the maximum elongation is about 85% (claims 1-18 and 48-50); a composite with two layers with elastic members and a machine and a cross-machine direction where the length is transverse to the machine direction, zones of attached elastics are interspersed with zones of unattached elastics where the zones of attached elastics are parallel to the machine direction extend across at least two elastic members, and pleats parallel to the machine direction and extend across at least two of the elastic members (claims 19-34); a composite with one layer and an elastic material where the length of the elastic material is transverse to the length of the composite with regions of securement interspersed across the width of the elastic composite and parallel to the length of the composite with regions of securement extending across the elastic material and pleats parallel to the length of the composite extending across a majority of the elastic material where the composite has a maximum elongation of 85% of the elastic material (claims 35-47).

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Glen Belvis on April 25, 2000 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-18 and 48-50. Affirmation of this election must be made by applicant in replying to this Office action. Claims

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19-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Applicant references various references throughout the specification and specifically references PCT WO 97/06299 as is incorporated by reference, however, the documents have not been provided or noted on Applicant's IDS. See pages 8, 10, 13, etc. of the specification.

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Double Patenting

5. Applicant is advised that should claim 12 be found allowable, claim 13 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is indefinite what applicant intends by the term “further”. In claim 9, for example, it is unclear whether applicant intends for the first layer to comprise a breathable material or whether the first layer is multilayered and will comprise a first layer in addition to further comprising a breathable material. For purposes of this examination, as noted in applicant’s examples, the term “further” will not be given patentable weight and the claims will read as the layers comprising

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the specified material, for example, claim 9 will read, "The composite material of claim 1 wherein the first layer comprises a breathable material."

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-18 and 48-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Pieniak, US 5098423.

Pieniak teaches a diaper with facing layer or topsheet formed of moisture pervious material which would allow air to pass through and therefore be breathable adjacent to an absorbent panel with a backing layer that may comprise moisture impervious material but is preferred to comprise a moisture pervious material such as a breathable non-woven fabric. See column 4, lines 24-57 and column 7, lines 56-68. The facing layer and the backing layer may also be made of an apertured non-woven fabric, which would allow air to pass through and therefore be breathable. See column 5, lines 36-46. Between the facing layer and backing layer are elastic members which are generally parallel (examiner determines "slightly out of parallel" and "roughly parallel" to be included in "generally parallel"). See column 6, lines 33-40 and figure 2. The elastic members can encompass sheets, films, ribbons, strands, elastic hot melt

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adhesives, elastomeric foams and nettings and the like, which clearly includes a plurality of elastic member comprising a single strand. See column 6, lines 1-14. The elastic members have an extensibility to rupture of at least about 150% and a recovery at 50% elongation of at least 50%, which clearly may include composites having a maximum elongation of at least 85%, 90% and 95%. See column 6, lines 25-32. The regions of securement are approximately the same size and are spaced approximately equally apart from each other. See figures 2 and 6. The elastics are also attached in specific areas, thus comprising zones of attachment which extend transverse across a majority of elastic members. See figures 2 and 6. The diaper is stiffened in that the opposite lateral edges of the barrier layer are folded inwardly over the opposite lateral edges of absorbent panel with the opposite lateral edges of the absorbent panel also folded inwardly. See column 8, lines 16-27. It would be an inherent property of the folding of the edges that the edges folded would be stiffened.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

11. Claims 1-18 and 48-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Kielpikowski, US 6056733.

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Kielpikowski teaches containment flaps for use absorbent articles, such as diapers, with a barrier layer that is generally liquid impervious, a bodyside liner that is liquid permeable and may contain natural fibers which would allow air to pass through and therefore be breathable, an outer cover that may be either liquid permeable or impermeable and may optionally be breathable, an absorbent core and elastomeric thread which may be used singly or multiply in a laterally spaced, generally parallel engagement (examiner determines “slightly out of parallel” and “roughly parallel” to be included in “generally parallel”). See column 2, lines 61 to column 3, line 11, column 4, lines 20-24 and 54-63, column 7, lines 33-47 and column 8, lines 1-30. Adhesive and ultrasonic bonding can be used to reduce the flexibility and increase the stiffness of the containment flaps. See column 2, lines 1-20. The elastomeric thread comprises any elastomeric material capable of being elongated at least about 50%, desirably about 350% and capable of recovering to within at least 250%, desirably about 150% of its original length after being elongated about 300%. See column 4, line 64 to column 5, line 13. Additionally the ends of the elastomeric thread can be attached to the barrier layer by any method known to those skilled in the art such as thermal bonding, adhesive bonding, ultrasonic bonding, knotting or the like. See column 5, lines 14-27.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Lee whose telephone number is (703) 308-0087. The examiner can

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normally be reached on Monday through Thursdays from 9:00 am to 6:30 pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ellis Robinson, can be reached on (703) 308-2364. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

The telephone number for the receptionist is (703) 308-0661.


Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700

LLL

May 5, 2000